

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING	DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,648	09/09	9/2003	John D. Morris	5621-P1	3164
49459	7590	02/03/2006		EXAMINER	
NALCO C	-		MCKANE, ELIZABETH L		
1601 W. DIEHL ROAD NAPERVILLE, IL 60563-1198				ART UNIT	PAPER NUMBER
	•			1744	
				DATE MAILED: 02/03/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)					
Office Action Summary		10/658,648	MORRIS ET AL.					
		Examiner	Art Unit					
		Leigh McKane	1744					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).								
Status								
1)[Responsive to communication(s) filed on	_•						
	This action is FINAL . 2b)⊠ This action is non-final.							
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is							
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11	I, 453 O.G. 213.					
Disposit	ion of Claims							
4)⊠	Claim(s) 1-31 is/are pending in the application.	,						
	4a) Of the above claim(s) is/are withdrawn from consideration.							
5)	5) Claim(s) is/are allowed.							
6)□	Claim(s) is/are rejected.							
·	Claim(s) is/are objected to.							
8)⊠	Claim(s) <u>1-31</u> are subject to restriction and/or e	election requirement.						
Applicat	ion Papers							
9)[The specification is objected to by the Examine	r.						
10)[The drawing(s) filed on is/are: a) acce	epted or b) objected to by t	he Examiner.					
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11)	The oath or declaration is objected to by the Ex	aminer. Note the attached Of	fice Action or form PTO-152.					
Priority (under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:								
/.	1.☐ Certified copies of the priority documents have been received.							
	Certified copies of the priority documents have been received in Application No							
	3. Copies of the certified copies of the prior	• •						
	application from the International Bureau	(PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.								
		·						
Attachmen	t(s)							
	e of References Cited (PTO-892)	4) Interview Summ						
	e of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	Paper No(s)/Ma 5) Notice of Inform	ail Date nal Patent Application (PTO-152)					
Paper No(s)/Mail Date 6) Other:								

DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 2, drawn to a fluorescent monomer, classified in class 546, subclass
 99+.
 - II. Claims 3-10, drawn to a tagged treatment polymer, classified in class 526, subclass 303.1.
 - III. Claims 11-17, drawn to a process of scale inhibition, classified in class 422, subclass 16.
 - IV. Claims 18-31, drawn to a method of maintaining a desired amount of a tagged treatment polymer, classified in class 436, subclass 55.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and III, as well as inventions II and IV, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the tagged treatment polymer can be used in another materially different process. For example, tagged treatment polymers like that claimed in Group II are often used as drilling muds for oil wells and as pusher fluids in enhanced oil recovery.

Application/Control Number: 10/658,648

Art Unit: 1744

3. Inventions I and III or IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together. Both inventions III and IV employ a polymer, not the monomer of group I.

Page 3

- 4. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. Invention III requires only that the polymer be added to an industrial water system in an amount "sufficient to inhibit scale formation." However, invention IV requires maintaining a desired concentration of the treatment polymer using measured fluorescence of the tagged polymer wherein the concentration is not related to scale formation.
- 5. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful in the tracing of process additives in industrial ceramics applications and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior

Application/Control Number: 10/658,648 Page 4

Art Unit: 1744

art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Nalco Chemical on January 26, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 571-272-1275. The examiner can normally be reached on Monday-Thursday (5:30 am-2:00 pm).

Application/Control Number: 10/658,648 Page 5

Art Unit: 1744

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leigh McKane

Leigh McKane

Primary Examiner

Art Unit 1744

elm

1 February 2006